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Edgar Pau

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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

HALL, ARTHUR O

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

10/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/965,605	Applicant(s) PAU ET AL.	
	Examiner ARTHUR O. HALL	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges applicants' cancellation of claims 1-22 and addition of claims 23-38 in the Response dated 7/24/2008 directed to the Non-final Office Action dated 1/24/2008. Claims 23-38 are pending in the application and subject to examination as part of this office action.

Examiner acknowledges that applicants' arguments in the Response dated 7/24/2008 directed to the rejection set forth under 35 U.S.C. 103(a) in the Non-final Office Action dated 1/24/2008 are deemed moot in light of a new ground of rejection under 35 U.S.C. 103(a) as set forth below in view of applicants' amendments and in view of applicants' arguments. However,

Claim Rejections - 35 USC § 103

Examiner sets forth new grounds of rejection under 35 U.S.C. § 103(a) with respect to new features as described below because each of the features of applicants' claimed invention as newly added continues to be unpatentable or obvious over the prior art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 23-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US Patent 6,776,711) in view of Yoseloff (US Patent 6,331,143). Features are described by figures with reference characters where necessary for clarity.

Regarding claim 31, Baerlocher teaches

a gaming machine (column 5, lines 5-10, Baerlocher) comprises
an electronic game controller (column 6, lines 15-27 and Fig. 2, 38, Baerlocher; a processor controls game processes as part of the computer) comprising
a player interface (column 5, lines 39-45, Fig. 1, 24 and Fig. 2, 46, Baerlocher; a bet button and touchscreen allow the player make selections in the game),
a display (column 5, lines 47-56 and Fig. 1, 32, Baerlocher; a video monitor displays game data), and
a program, wherein the program causes the electronic game controller to (column 5, line 65 to column 6, line 14, Baerlocher; program code controls the processor to execute game functions):

maintain a plurality of award sets each of which comprises a plurality of outcomes, each of the outcomes being either an integer having a positive value or a non-winning outcome (column 7, lines 11-42 and Fig. 3, 56a-e and 58a-e, Baerlocher; plural award sets are provided for different levels, wherein the award sets include plural

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awards, and the awards are numbers that are positive value integers and/or bonus terminators that have zero value representing non-winning outcomes),

wherein a total number of the integers having a positive value in any one of the award sets is not equal to a total number of the integers having a positive value in any other of the award sets (column 7, lines 22-34 and Fig. 3, 56a-e and 58a-e, Baerlocher; it would have been obvious at the time of invention to try an implementation in which the total quantity or number of positive value integer awards in the different ones of the plural award sets is not equal since each award set may be associated with a different numbers of awards), and

wherein a sum total of the positive value for all integers in any one of the award sets is equal to a sum total of the positive value for all integers in any other of the award sets (column 7, line 60 to column 8, line 2, column 11, lines 40-49 and lines 57-65 and Fig. 3, 56a-e and 58a-e, Baerlocher; it would have been obvious at the time of invention to try an implementation in which the sum total or sum resulting from adding together all the positive value integer awards is equal for all plural award sets since the game may be configured to employ any desired values of the awards in the plural sets);

select an award set from the plurality of award sets (column 10, line 63 to column 11, line 4, Baerlocher; the device may be configured to allow the player to make selections of award sets from all award sets in each award level);

wherein the game play credits have a value that is equal to the positive value of the integer selected from said selected award set (column 7, lines 22-34 and Fig. 3, 60 and 80, Baerlocher; awards of base credits are shown to be the value associated with the numbers in the award sets).

However, Baerlocher does not appear to teach selecting an outcome and awarding the player credits if the selected outcome is a positive integer value as claimed. Therefore, attention is directed to Yoseloff, which teaches

select an outcome from the selected award set (column 5, lines 29-35, Yoseloff; the device is configured to allow the player to select a subset of symbols for game play

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in order to effect a winning outcome if a match occurs, and it would have been obvious at the time of invention to try an implementation in which the subset of symbols selected are configurable as outcome selected from the awards associated with the award sets in Baerlocher since the subset of symbols may be selected as a group numbers in a row that make up the subset or as numbers from a set of symbols that make up the subset in the game); and

when the selected outcome is a said positive value integer, award a player game play credits (column 5, lines 36-48, Yoseloff; a player is awarded a payout upon occurrence of a match between the numbers or subset of player selected symbols and the subset of randomly selected winning symbols, and it would have been obvious at the time of invention to try an implementation in which the payout disclosed by Yoseloff is an award of game play credits as disclosed in Baerlocher since the award of base game credits is a payout having a particular value for game play).

Baerlocher suggests that a device that varies award returns and risk of bonus round termination will provide gaming devices that present the player with a risk of termination that is commensurate with the probability of receiving a high return award, thereby improving existing games in which the players return/risk is not altered as a result of bonus schemes having only one opportunity to generate a set of values and probabilities of selecting a certain award or bonus terminator that increases merely based on a reduction in the remaining selections (column 2, line 24 to column 3, line 23, Baerlocher).

Thus, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to modify Baerlocher in view of the teachings of Yoseloff for the purpose of providing the gaming device of Baerlocher having plural award sets provision and selection, positive integer value and game play credit features

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that are interchangeable with or upgradeable to the outcome selection credit award or payout features disclosed by Yoseloff in order to provide gaming devices that present the player with a risk of termination that is commensurate with the probability of receiving a high return award so as to improve existing games in which the players return/risk is not altered by varying award returns and risk of bonus round termination.

Regarding claim 23, the scope of the claims for the method of operating the system is inherent with respect to claim 31 above in view of the structure disclosed by Baerlocher and Yoseloff since the method is the normal and logical manner by which the system is employed.

Regarding claim 32, Baerlocher teaches

the program further causes the electronic game controller to (column 5, line 65 to column 6, line 14, Baerlocher; program code controls the processor to execute game functions):

select a further award set from the plurality of award sets (column 10, line 63 to column 11, line 4 and column 7, lines 43-49, Baerlocher; the device may be configured to allow the player to make selections of award sets from all award sets in each award level, and to allow the player to make their selections in each next advanced level);

wherein the further game play credits have a value that is equal to the positive value of the further integer (column 7, lines 22-34 and Fig. 3, 60 and 80, Baerlocher; awards of base credits are shown to be the value associated with the numbers in the award sets, and the credits are available in each next advanced level).

However, Baerlocher does not appear to teach selecting an further outcome and awarding the player further credits if the selected outcome is a positive integer value as claimed. Therefore, attention is directed to Yoseloff, which teaches

select a further outcome from the further award set (column 5, lines 29-35, Yoseloff; the device is configured to allow the player to select additional subsets of symbols for game play in order to effect a different winning outcome if a match occurs, and it would have been obvious at the time of invention to try an implementation in which the additional subsets of symbols selected are configurable as outcome selected from the awards associated with the award sets in Baerlocher since the subset of symbols may be selected as a group numbers in a row that make up the subset or as numbers from a set of symbols that make up the subset in the game); and

when the further outcome is a said positive value integer, award the player further game play credits (column 5, lines 36-48, Yoseloff; a player is awarded an additional payout upon occurrence of a match between the additional numbers or additional subset of player selected symbols and the additional subset of randomly selected winning symbols, and it would have been obvious at the time of invention to try an implementation in which the additional payout disclosed by Yoseloff is an award of game play credits as disclosed in Baerlocher since the award of base game credits is a payout having a particular value for game play).

Regarding claim 33, the player interface includes selectors operable by a player of the gaming machine and wherein, to select the award set and select the further award set, the electronic game controller allows a player, by operating the selectors, to select the award set and the further award set (column 8, lines 14-26 and Fig. 4, 32a, 60 and 62, Baerlocher; pick buttons integrated as part of a screen or touchscreen allow the player to select the number of award sets for each award level via the control of the processor).

Regarding claim 34, the highest value positive integer of one of the award sets is at least twice as large as the highest value positive integer of another of the award sets (column 7, lines 11-42 and Fig. 3, 56a-e and 58a-e, Baerlocher; award set 56e contains a highest positive value award of 70 that is greater than twice the highest positive value award of 25 contained in award set 56c).

Regarding claim 35, the number of integers is equal for each of the award sets (column 7, lines 22-34 and Fig. 3, 56a-e and 58a-e, Baerlocher; it would have been obvious at the time of invention to try an implementation in which the total quantity or number of positive value integer awards in the different ones of the plural award sets is equal since each award set may be associated with a different numbers of awards).

Regarding claim 36, within at least one of the award sets there is at least a factor of four difference between the highest and lowest values of said positive value integers (column 7, lines 11-42, column 7, line 60 to column 8, line 2, and Fig. 3, 56a-e and 58a-e, Baerlocher; it would have been obvious at the time of invention to try an implementation in which the difference between the highest positive value integer in any award set and the lowest positive value integer in any award set is greater than a factor of four since the game may be configured to employ any desired values of the awards in the plural sets).

Regarding claim 37, one only of the award sets has a single said positive value integer (column 10, lines 53-62 and Fig. 8, 56f and 58f, Baerlocher; award sets 56f and 58f have only one positive value integer).

Regarding claim 38, one only of the award sets has no said non-winning outcomes (column 7, line 60 to column 8, line 2, and Fig. 3, 56a-e and 58a-e, Baerlocher; award sets 56a-b and 58a-b have no bonus terminator or zero value non-winning outcome, and it would have been obvious at the time of invention to try an implementation in which only one of the award sets has no bonus terminator or zero

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value non-winning outcome since the game may be configured to employ any desired values of the awards in the plural sets).

Regarding claims 24-30, the scope of the claims for the method of operating the system is inherent with respect to claims 32-38, respectively, above in view of the structure disclosed by Baerlocher and Yoseloff since the method is the normal and logical manner by which the system is employed.

Response to Arguments

Applicants' arguments filed in the Response dated 7/24/2008 directed to the Examiners' rejection under 35 U.S.C. § 103(a) have been considered fully and are moot in light of a new ground of rejection under 35 U.S.C. 103(a) as set forth above in view of applicants' amendments and in view of applicants' arguments thereof.

Examiner has provided the above new grounds of rejection of the claims under 35 U.S.C. 103(a) because each of the features of applicants' claimed invention continues to be unpatentable or obvious over the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

B US-6,159,096, Yoseloff

C US-6,062,981, Luciano, Jr.

D US-5,401,023, Wood

E US-6,309,300 B1, Glavich

F US-6,439,993 B1, O'Halloran

G US-6,743,102 B1, Fiechter et al.

H US-6,183,361 B1, Cummings et al.

I US-6,666,767 B1, Dayan

J US-6,857,959 B1, Nguyen

K US-6,213,876 B1, Moore, Jr.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARTHUR O. HALL whose telephone number is

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(571)270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. O. H./
Examiner, Art Unit 3714

/Scott E. Jones/
Primary Examiner, Art Unit 3714